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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,168	06/02/1999	HIROYUKI NITTA	500.33793R00	1146

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EXAMINER

WU, XIAO MIN

ART UNIT PAPER NUMBER

2674

DATE MAILED: 10/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/324,168

Applicant(s)

NITTA ET AL.

Examiner

XIAO M. WU

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Reissue Applications***

1. The original patent filed 1/11/2002 has been received
2. Upon further considering the application, the previous Final office action is withdrawn and a new office action is provided as follow.
3. Claims 1-31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.
4. Specific attention is directed to the new independent claims 17, 21 and 25. As set forth in applicant's reissue declaration, applicant states that "at least one error of the patentees claiming more or less than the patentees had the right to claim in the original patent upon which reissue is based is the recitation in claim 1 of the original patent of "simultaneously generates two different display voltages from the selected display voltage level"". During the prosecution of the parent application, applicant added the above limitations into the claim 1 of the parent application to

Art Unit: 2674

distinguish the prior art reference to Yamazaki. And at paper No. 12 of the parent file, applicant specifically argued that Yamazaki's level shifter circuit 216 does not simultaneously generate two different display voltages as does output means 129, 131 in Figs. 9 and 11 of the present application.

5. As set forth in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); arguments made to overcome prior art, even when made in absence of any claim amendment, can evidence admission sufficient to give finding of surrender within meaning of recapture rule, which prohibits grant of reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution.

6. Applicant's independents 17, 21 and 25 are broader than the original patent claim 1 in exactly the area argued for patentability in the parent prosecution. Although claims 17, 21 and 25 include some additional limitations making the reissue claim narrower than the patent claim in other aspects, these additional limitations presented in the reissue are not related to the limitation that was added during the original prosecution to overcome the art rejection. For example, the newly added limitation of "said display voltages including a set of positive and negative polarity gray scale voltages corresponding to each of gray scales" is not related to the limitation of "simultaneously generates two different display voltages from the selected display voltage level" that was added during the original prosecution to overcome the art rejection. The reissue claims 17, 21 and 25 entirely omits the limitation that was added during the original prosecution to over come an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue narrower than the patent claim in other aspect, is

Art Unit: 2674

impermissible recapture, see *In re Pannu v. Sctorz Instruments Inc.* 258 F,3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

7. Applicant's arguments filed 6/4/2003 have been fully considered but they are not persuasive.

8. Applicant argues that the newly added narrowing limitations in the reissue claims 17, 21 and 25 are not defined anywhere in each of the original base claims 1, 11 and 16 of US Patent No. 5,774,106, and modify the claims such that the scope of the claims no longer results in a recapture of the alleged surrendered subject matter. These arguments are not persuasive because the reissue claims 17, 21 and 25 entirely omits the limitation that was added during the original prosecution to over come an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue narrower than the patent claim in other aspect, is impermissible recapture, see *In re Pannu v. Sctorz Instruments Inc.* 258 F,3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2674

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiao Wu whose telephone number is (703) 305-4721.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231


**or faxed to:**

**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377

xw  
October 1, 2003

  
**XIAO WU**  
**PRIMARY EXAMINER**  
**ART UNIT 2674**